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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/702,625    08/23/96    KLUTH

H    H1215/1556PC

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IM22/0812

EXAMINER

COONEY, J

ART UNIT

PAPER NUMBER

1711

DATE MAILED: 08/12/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
08/702,625

Applicant(s)

Kluth et al.

Examiner

John Cooney

Group Art Unit  
1711



☒ Responsive to communication(s) filed on May 24, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 15-36 and 40-68 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 15-36 and 40-68 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's arguments filed 5-24-99 have been fully considered but they are not persuasive.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 15-36, and 40-68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pauls(4,263,412) in view of CA-2,084,698 (previously cited by applicants, and Minato et al.(5,086,175)(previously cited by applicants).

Pauls discloses preparations of polyurethanes dispensed from a pressure can for dispensing polyurethane foam materials wherein a foam precursor material comprising isocyanate group containing prepolymers, blowing agents, catalysts, and other additives is stored under pressure and foamed upon release (see the entire document).

Pauls differs from applicants' claims in that it does not particularly specify the removal of residual monomeric isocyanate from its reactive components. However, CA-2,084,698 and Minato et al. (see both documents in their entireties) set forth that the means for removing excess monomer from isocyanate based reactive materials has long been known to the art for the purpose of reducing toxicity. CA 2,084,698 sets forth the more commonly recognized distillation method, and Minato et al. discloses the film evaporation methods. Accordingly, it would have been obvious for one having ordinary skill in the art to have reduced residual monomer contents of the prepolymers placed in the systems of the Pauls reference (inadvertently referred to as Plaschka et al. at this point in the rejection in the previous Office action but referred to properly at all other points in the previous rejection - error was clearly typographical and did not serve to confuse the effects of the rejection) by the methods set forth by CA-2,084,698 and/or Minato et al. for the purpose of reducing toxicity in order to arrive at the systems, processes, and products of applicants' claims in the absence of a showing of new or unexpected results.

CA-2,084,698 and Minato et al. are applied in much the same manner as set forth in the previous Office action. Their application is maintained to be proper even though they are not particularly concerned with foaming. The determination that a reference is from a nonanalogous art is twofold. First, it is decided if the reference is within the field of the inventor's endeavor. If it is not, then it must be determined whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174; *In re Clay*, 23 USPQ.2d 1058. Disclosures of preparing isocyanate components for polyurethane synthesis having reduced monomeric isocyanate contents is at least pertinent to the endeavors of a referenced inventor who is using isocyanates in preparations of isocyanate components used in

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prepolymers which are dispensed from cans. The fact that the secondary references may not form foams does not negate their pertinence and relevance to the endeavor of preparing polyurethane products whose fundamental behaviors at a chemical level are not affected by the presence or absence of a blowing agent. Accordingly, it is maintained that an ordinary practitioner in the polyurethane arts would find the teachings of CA-2,084,698 and Minato et al. relevant and pertinent to the teachings of Pauls.

Rejection is maintained for the reasons set forth in the previous Office action (note typographical correction pointed out in bolds above). Applicants' arguments stating that motivation to utilize the monomers of CA-2,084,698 and Minato et al. in the vessels of Pauls is not evident. However, one would have been motivated to have utilized the low monomer containing prepolymers of CA-2,084,698 and Minato et al. in the Pauls system for the purpose of having minimized residual toxic material contents in waste materials with the expectation of success. The fact that these efforts may be expensive relative to their environmental benefits has no bearing on whether motivation is evident. An ordinary practitioner in the art would logically and obviously be directed towards using low toxic monomer containing prepolymers available to him in a prepolymer dispensing system if environmental integrity was at the forefront of his endeavors. Applicants' invention as claimed is utilizing that which is known to the art to the achievement of obvious ends and no invention in a patentable sense is seen.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

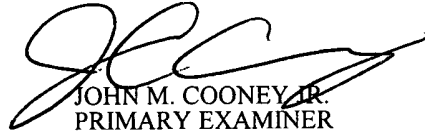
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is (703)308-2433. The examiner can normally be reached on Monday - Friday from 9AM-6PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The Official fax phone number for this Group is (703) 305-3599. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JMC  
8-10-99



JOHN M. COONEY, JR.  
PRIMARY EXAMINER  
GROUP 1700